

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

030455; 190250-1580

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/686,433

Filed

October 14, 2003

First Named Inventor

Daniell, et al.

Art Unit

2457

Examiner

Lai, Michael C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/sfb/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Anthony F. Bonner

Typed or printed name

☒ attorney or agent of record.
Registration number 55012

770-933-9500

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

August 14, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Confirmation Number: 7279

Daniell, *et al.*

Group Art Unit: 2457

Serial No.: 10/686,433

Examiner: Lai, Michael C.

Filed: October 14, 2003

Docket No. 030455; 190250-1580

For: Processing Rules for Digital Messages

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Appellants submit the following remarks in support of a Request for a Pre-Appeal Brief Conference.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

REMARKS

Appellants submit that the following clear legal deficiency exists in the rejection. Namely, the previous Office Action and Advisory Action neglect to acknowledge that *Malik* has the same filing date as the present application. Further, the Response submitted June 2, 2009 clearly illustrates that *Malik* does not claim the benefit of any provisional application and thus has an effective filing date that is inapplicable as prior art for the present application.

I. Status

Claims 26 and 27 are rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1, 2, 10, 11, 18 – 20, and 25 – 27 are rejected under 35 U.S.C. §102(b) as allegedly being unpatentable over U.S. Publication Number 2004/0078445 ("*Malik*").

II. Rejections Under 35 U.S.C. §101

The Office Action indicates that claims 26 and 27 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Appellants traverse this rejection but do not otherwise address this rejection at this time.

III. Rejections Under 35 U.S.C. §102

A. Claims 1, 2, 10, 11, 18 – 20, and 25 – 27 are Allowable Over *Malik*

The Office Action indicates that claims 1, 2, 10, 11, 18 – 20, and 25 – 27 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Publication Number 2004/0078445 ("*Malik*"). Appellants respectfully traverse this rejection. As indicated above, *Malik* has a filing date of October 14, 2003, which is the same filing date as the present

application. The Examiner argues that *Malik* claims priority to a number of provisional applications, thus giving *Malik* an earlier effective filing date. Appellants respectfully disagree.

More specifically, despite the indication of priority on the front page of the *Malik* published application (U.S. Application Number 2004/0078445), in the supplemental response submitted June 2, 2009 for the present application, Appellants submitted numerous documents illustrating that *Malik* never claimed priority to any provisional application. Included in the June 2, 2009 submission is:

(1) The corrected filing receipt dated February 26, 2004 for the 10/685,970 application (*Malik*), illustrating that no domestic priority is claimed (see PAIR for Application Number 10/686,433 – “Request for Corrected Filing Receipt” submitted 06-02-2009, page 1 of 5);

(2) The original filing receipt for *Malik* dated January 15, 2004, illustrating an incorrect domestic claim to priority (see PAIR for Application Number 10/686,433 – “Request for Corrected Filing Receipt” submitted 06-02-2009, page 3 of 5);

(3) The request to correct the January 15, 2004 filing receipt dated February 6, 2004. This document clearly indicates that the domestic priority data is incorrect (see PAIR for Application Number 10/686,433 – “Request for Corrected Filing Receipt” submitted 06-02-2009, page 4 of 5); and

(4) The first page of *Malik* as filed, clearly indicating that the provisional applications are incorporated by reference only and not claimed for priority (see PAIR for Application Number 10/686,433 – “Request for Corrected Filing Receipt” submitted 06-02-2009, page 5 of 5).

While the Examiner indicated that these documents are not available in PAIR under U.S. Application Number 10/685,970 (*Malik*), Appellants nevertheless submit that these documents are copies of the actual documents submitted and/or received from the United States Patent and Trademark Office for the *Malik* application.

Consequently, *Malik* is only afforded its actual filing date (which is the same date as the present application) because these provisional applications were only incorporated by reference and not claimed for priority. As such, the filing dates of those provisional applications cannot be relied upon to reject the present application. For at least this reason, Appellants submit that there is clear error in the rejection and submit that the pending claims are allowable.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the re-opening of prosecution on the merits of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

/afb/

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